2822

Response to 7-2-03
Queen
10/2/03

Attorney Docket No. 0756-1838

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	)	Group Art Unit: 2822
Shunpei YAMAZAKI et al.	)	Examiner: M. Guerrero
Serial No. 09/118,010	)	
Filed: July 17, 1998	)	
For: SEMICONDUCTOR DEVICE, METHOD OF FABRICATING SAME, AND ELECTROOPTICAL DEVICE	)	

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 10-1-03.

Adele M Stamper

RESPONSE

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Official Action mailed July 2, 2003, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on July 17, 1998, March 21, 2000, April 25, 2000, July 17, 2000, November 30, 2000, March 9, 2001, April 11, 2001, and November 2, 2001.

Claims 1-8 and 11-73 are pending in the present application, of which claims 1, 5, 11, 12, 18, 23, 28, 33, 38, 40, 43, 47, 53, 59, 64 and 69 are independent. The Applicants note with appreciation the allowance of claims 1-8 and 11-46.

Paragraph 2 of the Official Action rejects claims 47-73 as obvious based on the combination of U.S. Patent No. 5,055,899 to Wakai et al., U.S. Patent No. 5,427,961 to Takenouchi et al., and U.S. Patent No. 5,066,110 to Mizushima et al. The Applicants respectfully traverse the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. Wakai, Takenouchi and Mizushima do not teach or suggest a second resinous substrate opposed to a first resinous substrate. Claims 47-73 recite a second resinous substrate opposed to a first resinous substrate. The Official Action concedes that Wakai does not teach a second resinous substrate opposed to a first resinous substrate (p. 3, Paper No. 51). The Official Action relies on Mizushima to allegedly teach "a pair of insulating substrates" (Id.). However, it appears that Mizushima does not teach that the second substrate is resinous.

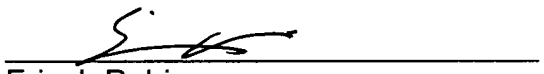
Takenouchi does not cure the deficiencies in Wakai and Mizushima. The Official Action relies on Takenouchi to allegedly teach a resinous substrate and a resinous layer on the resinous substrate. Wakai, Takenouchi and Mizushima, either alone or in

combination, do not teach or suggest a second resinous substrate opposed to a first resinous substrate.

Since Wakai, Takenouchi and Mizushima do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



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